



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#7  
LDT  
5-31-02

In Re Appln. of: Robert Filepp et al.

Group Art Unit 2153

Serial No.: 09/656,581

Examiner: Dung C. Dinh

Filed: September 6, 2000

Title: AN INTERACTIVE NETWORK AND  
METHOD OF OPERATION

RECEIVED  
MAY 30 2002  
Technology Center 2600

## REPLY TO OFFICIAL ACTION

Assistant Commissioner of Patents  
Washington, D.C. 20231

Sir:

In reply to the Official Action dated November 23, 2001, Applicants submit the below-noted remarks, and, request that their application be reconsidered in light of those remarks.

## REMARKS

### I. SUMMARY

In the November 23, 2001 official action (Action), the Examiner cited no prior art against Applicants' pending claims 1-51. Nonetheless, the Examiner rejected Applicants' claims 1-51 as unpatentable under 35 USC §112, Para. 1, on the grounds that the written description included in Applicants' specification did not "reasonably convey to one skilled in the relevant art that ... at the time their application was filed, [Applicants] had possession of the claimed invention" (Action, p2). Applicants' would respectfully submit, however,

that in asserting the rejection, the Examiner has failed to establish a *prima facie* case of unpatentability pursuant to 35 USC §112, Para. 1 against pending claims 1-51.

In asserting the rejection, the Examiner contended that of the several intertwined 35 USC §112, Para. 1 requirements, namely: need for a written description that conveys the inventor was in "possession of the claimed invention" when filed on; enablement that permits the "making and using" of the claimed invention; and presentation of the "best mode" for carrying out the claimed invention, Applicants' specification did not include a written description that reasonably conveyed to one skilled in the art that Applicants were in possession of the claimed invention, because, as the Examiner contended, Applicants' specification did not support "a location designation"; or "an advertiser host to provide advertising content"; or "an advertisement host"; or certain of their respective functional during operation. (Action, pp 2-5). However, in making the rejection, the Examiner failed to apply the criterion and considerations the Court of Appeals for the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals, have long maintained for assessing adequacy of an applicant's written description relative to the requirements of 35 USC §112, Para. 1.

Specifically, the Examiner failed to correctly assess what Applicants' specification, in fact, expressly teaches. Further, the Examiner failed to consider whether matter the Examiner contends is missing from Applicants' written description would have been reasonably understood by one of ordinary skill in the art based on what Applicants' written description does disclose. Still further, the Examiner failed to consider that Applicants are not required to expressly include in their written description all matter known by persons skilled in the art to which Applicants' invention relates.

Still further, Applicants would respectfully submit that full review of their disclosure demonstrates that Applicants expressly teach placement of the identification code "ADSL0T" in ad partitions of an application page layouts supplied by the file server, which code "locates," in simplified operation of Applicants' system, the high function host of Applicants' information layer, that, in turn, identifies user-targeted advertisement content

which can be retrieved, for example, from a gatewayed advertiser host, and placed in respective ad partitions. As such, the ADSLOT identification code constitutes “a location designation” for Applicants’ high function host and its subsequent identification of targeted advertising to be displayed.

Additionally, Applicants would respectfully submit that full review of their disclosure demonstrates that Applicants expressly teaches use of information layer computing resources, particularly, the high function host, that supplies and receives network information to serve as a source for lists; i.e., queues, of identifiers for advertising objects targeted to respective users; and, further, receive user-activity information originated at respective user reception systems to enable user advertising targeting, which, thereby, constitute “an advertisement host.” Yet, additionally, Applicants would respectfully submit that full review of their disclosure demonstrates that Applicants expressly teach employment of respective “advertiser hosts” that users access over network gateways to provide advertising content information to users who have requested advertising.

Accordingly, Applicants would respectfully submit that contemplation of Applicants’ express teaching regarding the ADSLOT location designation of the high function host; high function host operation; and access to gatewayed advertisers by those skilled in the art would make it obvious to those skilled in the art that as of Applicants’ effective filing date, Applicants possessed a networked system for presenting targeted advertising to users as described in pending claims 1-51.

Therefore, Applicants’ would further respectfully submit that their disclosure does, in fact, include a written description that complies with 35 USC §112, Para. 1, and that the Examiner’s rejection of pending claims 1-51 must be withdrawn.

## **II. APPLICANTS’ DISCLOSED SYSTEM**

Applicants’ claimed invention is a method and apparatus for presenting interactive applications concurrently with user-targeted advertising in a distributed processing,

computer network. In accordance with the invention, Applicants' network features a plurality of user reception systems; i.e., terminals, at which the interactive applications and advertising can be exhibited, the respective reception systems including a personal computer having a monitor for concurrently presenting the visual portion of the interactive applications and advertising as one or more screens of display.

In accordance with their invention, Applicants designed and developed a network architecture that enables the interactive applications and advertising to be structured such that they are partitioned; i.e., divided, into pages; i.e., screen of display, presented at respective user reception system monitors. Also in accordance with their invention, the Applicants' network architecture enables the respective screens of display to be further subdivided into addressable screen partitions; i.e., independent screen parts, that permit independent content to be presented at the respective screen partitions. As a result, based on Applicants' network architecture, applications and advertising which are independent of each other, can be concurrently presented at respective screen partitions. And, because of this network architecture, advertising targeted; i.e., custom tailored to the user, can be presented to the user concurrently with and independently of whatever application the user desires and requests.

To achieve the noted display independence for applications and advertising, and to avoid the burden of communication line traffic arising from multiple data streams for independent advertising and application content, in accordance with their invention, Applicants undertook to organize the application and advertising data as multiple units; particularly data objects, that could be readily and independently distributed throughout the network. In accordance with Applicants' teaching, applications and advertising objects are configured alike, the difference between the two object types being their respective subject matter. In that way, the applications and advertising information can be supplied to the user reception system in the same data stream, but, upon reaching the user reception system, be broken out for independent, but, concurrent presentation.

Pursuant to Applicants' design, application and advertising objects are configured as self-defining structures that package display data or program code or both, to effect page and page part presentation and processing; e.g., transactions. In this arrangement, each application or advertising partition can represent a screen or a partial screen of information, and include fields for accepting data employed in supporting transactions within the interactive service. Further, as part of this architecture, objects respectively feature: a header including an object identification and other object parameters; and a sequence of segments that contain the display data or program code or both for effecting object presentation and operation.

More specifically, the object header identification; i.e., object id, preferably includes such parameters as the length of the object identification, object access control and object type designation. Additionally, the object id features a designation for the object in the system, the designation including, in preferred form, the identification of the object set to which the object belongs and the object placement in the set. Accordingly, the designation identifies the grouping of the object relative to other objects; the set to which the object belongs and the placement of the object in the set; i.e., a virtual address for the object.

Further, in addition, to the object id, the object header, preferably, also includes such parameters as the object length, storage candidacy and version.

As to object segments, the segments are of various types and are the basic building blocks of objects. Segments, as in the case of the objects, are also self-defining and have a specific structure; particularly, a designation of type, identification of length, followed by the information necessary to implement the segment and its associated object; e.g., either, control data, display data or program code. Additionally, a segment may include an embedded object or a call to another object.

Based on this arrangement, and in accordance with Applicants' teaching, where a page partition; i.e., screen partition, is assigned advertising content, the data structure for the advertising screen partition may include an advertising object having advertising display data and/or program code that enable the calling and associated location through the

called object id and its associated address; i.e., object group, set and item location, of successive objects for the presentation of additional pages of advertising and/or the presentation of associated advertising transactions.

As Applicants also explain in their specification, when an application page is presented at the user reception system, the reception system object processor makes a request to the reception system object storage facility for the page template object; i.e., specification, for the page, which page template object includes the makeup and layout information for the page. Based on the content of the page template object, the object processor builds a page processing table which includes the page makeup elements; e.g., page format objects, page partition, page element objects, ad objects and any required program objects. When in the course of building the page, the object processor encounters a call to an "ADSLOT" identification code associated with an ad page partition, the object processor requests the next advertising object id at the reception system ad manager ad queue, which, as noted below, arises from the information layer high function host, and the identified advertising object is retrieved based on the object id either locally, or from the network depending on availability, so that the presentation data for the advertising can be displayed. Additionally, the object processor passes all ids for the objects used in the page presentation to reception data collection manager for use in ad targeting and other purposes.

Continuing, and with regard to Applicants' network architecture, as noted, Applicants' system includes a file server and associated application object and advertising object database. Additionally, the system includes a multiplicity of user reception units which communication with the file server and other network components. Still further, Applicants' system includes an information layer including: "high function system" computing resources; "producer system" computing resources; and "business support system" computing resources. In accordance with Applicants' teaching, the high function system operates online and collects user experience and demographic data for

profiling users, and additionally manages the production of advertising lists; i.e., queues, targeted; i.e., custom tailored, to users by the offline business support system.

Further, the high function host supervises user logon to the system and provides respective user reception units that logon to the system with: data for activating the user-activity data collection manager; ad queues of targeted advertising; as well as parameters for configuring the user reception system ad queue manager. Additionally, during online operation, the high function host receives requests from respective user reception units for additional targeted ad queues as ads are displayed and the initial ad queues depleted. And, yet further, during online operation, the high function host receives data from user reception unit data collection managers concerning user activity experience, which the high function host subsequently makes available for offline modification of user profiling and preparation of user targeted ad queues.

In view on the described operation of the high function system, and its supply and receipt of operating information, it is apparent that in accordance with Applicants' teaching the high function system operates as a hosting facility. And, in view of the high function host's operation in connection with data collection for advertising targeting, and supply and support of targeted ad queues including ad object ids; i.e., object addresses, the high function host clearly operates as an advertisement host.

Again with regard to network architecture, Applicants' system is additionally seen to include a "gateway system" that permits user reception systems to be operationally connected to third-party hosts; e.g., advertiser hosts, that are able to supply application and advertising content to requesting user reception systems. Particularly, just as objects are able to include display data and/or program code which calls for advertising objects from the file server and information layer host, object may also include calls for access to third-party hosts of advertisers over the gateway system, thereby, enabling the gatewayed advertiser hosts to supply interactive advertising content that may be displayed at the user reception unit.

Concerning operation, in accordance with their teaching, Applicants' architecture is capable of various modes of operation. As outlined above, Applicants' system includes architecture that permits a network configuration capable of supporting a four-element arrangement; e.g., a content host; a user reception system; an advertisement host in the form of Applicants' high function host; and an advertiser host in the form of a gatewayed third-party host. Additionally, and as also outlined above, Applicants' architecture supports a location designation in the form of the ADSLOT identification code associated with ad partitions that, in simplified operation of Applicants' system, "locates" Applicants' high function host, which, in turn, identifies user-targeted ad content for ad partitions, which content may be received; for example, from a gatewayed advertiser host.

However, in order to concisely explain the simplified operation of Applicants' system it is helpful to first describe Applicants' preferred form of operation.

In the preferred form of operation, Applicants' architecture, in addition to addressing the basic tasks of supplying and presenting independent applications and targeted advertising concurrently at a user reception unit, also addresses other interactive network system problems, particularly, the problems of system communication line traffic and host complexity.

More specifically, as pointed out in Applicants' specification, where network architecture relies on hosted-centered processing, host complexity and communication line traffic is caused to increased, while system speed is caused to decrease where heightened processing is required of the host. Applicants' design, however, in preferred form, undertakes to limit the effects of such problems by relying on distributed processing that features greater reliance on the computing resources of the user reception system, as for example, with the use of application and advertising content data storage and management at the reception system. As explained by Applicants, such an approach serves to move more of the system data processing burden to the user site, and to reduce the demand on and complexity of the system host. Additionally, and as also explained in their disclosure, Applicants' system preferably employs other strategies to help reduce line traffic, for



example, pre-fetching advertising to the user reception system and maintaining an independent reception system ad queue that is periodically replenished as targeted ads are presented.

With regard to Applicants' preferred form of system operation, at system logon, the user activates the logon application at his reception unit. A logon request message including the user personal entry code and password is sent to the system file server and directed to the high function host of the information layer where the user is confirmed for entry to the system. Once logon is achieved, the ad manager of the user reception system sends a request to the high function host requesting a targeted ad queue. The high function host respond by: providing the parameters for the ad manager ad queue; i.e., queue capacity, replenishment value and a pre-fetched advertising threshold; supplying an ad queue, including a number of initial ad ids; and signaling "on" to the reception unit data collection manager. Thereafter, the user reception unit applies and stores the high function supplied ad queue information, obtains several initial ad objects identified in the supplied ad queue, and activates its data collection manager, thus, configuring the reception unit for targeted ad processing. (Spec p13, lns26-32; p124, lns25-29; p134, lns14-29).

Once the logon and ad queue setup are completed, the user is free to begin accessing system applications and concurrently displayed advertising. For purposes of discussion, assume at this point the user has been accessing the service for a while, and the ad queue has fallen to the level requiring replenishment. In accordance with Applicants' teaching, the reception system ad manager sends a request to the high function host for refreshment of the user ad queue. In response, the high function host sends the user reception unit a list of new ids for ad objects targeted to the user, which the reception unit ad manager enqueues.

Subsequently, when the user requests a desired application, as explained in Applicants' disclosure, the associated application objects are collected from the user reception unit and the network as availability requires. Thereafter, as the user reception system builds the application initial page, and the object processor encounters a page partition that includes

an ADSLOT identification code, the object processor calls the reception system ad manager to supply the id of an ad object, the object id being included in the object header. In response, the ad manager presents the object processor with the id for the lead object from the ad queue supplied by the high function host.

Following this, the object processor calls for the object identified by the high function host based on the virtual address contained in the object header, the object header including the object id which itself includes the address information concerning the object set and set item designation. Based on that address information, the object processor requests the identified object, which is retrieved, and the application page with the associated initial page of a targeted ad is presented at the user reception unit.

Accordingly, now available at the user reception system is the application page the user originally requested, together with the initial page of a concurrently presented ad, the ad initial page including the identification for the subsequent page of the ad in the form of calls and associated program instructions to retrieve the ad subsequent page.

Thereafter, if the user selects; i.e., activates, the initial page of the concurrently presented ad, the program code of the object associated with the initial ad page will cause the subsequent ad page to be retrieved based on the address contained in the header of the subsequent ad page object called in that process and/or instructions to contact a gatewayed host; e.g., an advertiser host, for additional advertising content.

However, and as would be appreciated by those skilled in the art, Applicants' described architecture is also capable of operating in a more simplistic fashion. Particularly, where host complexity and line traffic are not sought to be diminished, Applicants' system is also capable of operating, albeit not preferably, with restricted user reception system storage for targeted advertizing; i.e., with no ad queue; and no pre-fetching of targeted advertising object ids. In effect, and as would be appreciated by those skilled in the art, this amounts to having the ADSLOT identification code associated with an ad partition in a user requested application page received from the file server, immediately locate Applicants' high function host by calling the reception system ad manager for an ad object id, which,

because of the absence of any ad queue, requires the ad manager to immediately call to the high function host for the id of a targeted ad, as the ad manager would otherwise do to replenish the ad queue were it present.

More specifically, and as would be apparent to those skilled in the art, where concerns regarding host complexity and communication line traffic are not substantial, and ad pre-fetching and queuing at the user reception system are suspended, Applicants' architecture is capable of operation generally similar to preferred operation, but, notably simpler. Particularly, with the simplified approach, operation would be as follows.

At system logon, as in the case of preferred operation, the user activates the logon application at his reception system, and sends a logon request message including his personal entry code and password to the system file server, which message is subsequently directed to the high function host of the information layer, where, if qualified, the user is confirmed for entry to the system. Once logon is achieved, the user reception system ad manager sends a request to the high function host for activation of the reception system data collection manager, no request for an ad queue, ad queue parameters, or pre-fetched ads being required.

Thereafter, the high function host responds by signaling the reception system data collection manager "on." Subsequently, on receipt of the high function response, the user reception system activates its data collection manager, and awaits user access of system applications and concurrently displayed advertising.

Following the noted setup sequence, when the user elects to view a desired application and requests it, as noted above, the associated application objects are collected from the user reception system and the network as availability dictates. Thereafter, as the user reception system builds the initial application page, and the object processor encounters an ad page partition that includes an ADSLOT identification code, the ADSLOT code immediately "locates" Applicants' high function host by calling the reception system ad manager for an ad object id, which, because of the absence of any ad queue, requires the ad manager to immediately call to the high function host for the id of a targeted ad, as the

ad manager would otherwise do to replenish the ad queue if it were present. In response, the high function host then does what it would otherwise do if an ad queue were present at the user reception system, namely, designate a target ad id for the user based on known characteristics of the user, and return the id to the reception ad manager, which, then, provides the id to the object processor. Subsequently, the object processor calls the object for the ad initial page the high function host has designated based on the virtual address contained in the object id, and when received, includes the object at the ad page partition that carried the ADSLOT code. Thereafter, the application page with the associated initial page of the targeted ad is presented at the user reception system.

Following the noted procedure, as in the case of preferred operation, there would be available at the user reception system the application page the user originally requested, together with the initial page of a concurrently presented ad, the ad initial page including the identification for the subsequent page of the ad in the form of a call and associated program instructions to retrieve the ad subsequent page.

Subsequently, and as noted in the case of the preferred operation, if the user selects; i.e., activates, the initial page of the concurrently presented ad, the program code of the object associated with the initial ad page will cause the subsequent ad page to be retrieved based on the address contained in the header of the subsequent ad page object called in that process and/or instructions to contact a gatewayed host; e.g., an advertiser host, for additional advertising content.

Accordingly, and as would be appreciated by those skilled in the art, in simplified operation, where the Applicants' system is configured in a four element configuration, namely: a content host; i.e., file server; reception system; advertiser host; i.e., gatewayed host; and an advertisement host; i.e., high function host, the ADSLOT identification code, when received from the file server with application content, acts as a location designation that locates the high function host, which, in turn, designates the id of an advertising object targeted to the user, that when included in the application page enables the user, based on

the content of the designated ad object, to obtain subsequent ad content from a gatewayed advertiser host.

### **III. THE LAW**

#### **Applicants Are Required to Provide a Written Description of Their Inventions**

The Patent Act, in pertinent part, provides:

The specification [of a patent application or patent] shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 USC §112, 1 (BNA 2002).

It has long been recognized that to meet the requirements of 35 USC §112, Para. 1, patent applications and patents must contain a written description of the claimed subject matter so that persons skilled in the art would understand the inventors were in possession of claimed inventions when filed on. In describing this requirement of the statute, the Court of Appeals for the Federal Circuit has noted that while inventors must convey with reasonable clarity to those skilled in the art that they were in possession of the invention as of their filing date, the inventors need only reasonably convey possession of that subject matter.

Moreover, the Federal Circuit has noted that inventors do not have to describe exactly in the specifications the subject matter claimed, nor, matter known to those skilled in the art. Stated otherwise, the sufficiency of the written description depends on what the inventor expressly discloses, and what would be known to one of ordinary skill in the art. Still further, the Federal Circuit has continually maintained that determination of the adequacy of the inventor's description is a question of fact which must be resolved on a case-by-case basis. In that regard, the Federal Circuit has established that the Patent and

Trademark Office has the burden of presenting evidence as to why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.

More specifically, in *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991), the Federal Circuit noted that the Court had often considered the "written description" requirement of 35 USC §112, and that while the inventor was required to show possession of the invention at the time of filing his application, the test was whether the inventor's description "reasonable" conveyed to the artisan that possession. Specifically the Court said:

Since its inception, the Court of Appeals for the Federal Circuit has frequently addressed the "written description" requirement of §112. A fairly uniform standard for determining compliance with the "written description" requirement has been maintained throughout: "Although [the applicant] does not have to describe exactly the subject matter claimed, ... the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (citations omitted). "[T]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). Our cases also provide that compliance with the "written description" requirement of §112 is a question of fact, .... *Gosteli*, 872 F.2d at 1012, 10 USPQ2d at 1618; *Utter v. Hiraga*, 845 F.2d 993, 998, 6 USPQ2d 1709, 1714 (Fed. Cir. 1988).

*Vas-Cath Inc. v. Mahurkar* 19 USPQ2d at 1116.

Additionally, the Federal Circuit recently noted in *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 54 USPQ2d 1227 (Fed. Cir. 2000) that the inventor does not have to "describe exactly" claimed subject when asserting it is supported by the his written description. Here the Court observed:

In written description cases, "[t]he primary consideration is factual and depends on the nature of the invention and the amount of knowledge

imparted to those skilled in the art by the disclosure." *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976) (emphasis added).

The written description requirement does not require the applicant "to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (citations omitted). Thus, Section 112, Para. 1 ensures that, as of the filing date, the inventor conveyed with reasonable clarity to those of skill in the art that he was in possession of the subject matter of the claims. See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

*Union Oil Co. of California v. Atlantic Richfield Co.*, 54 USPQ2d at 1232. In this regard see also *In re Lukach*, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971); and *In re Eltgroth*, 419 F.2d 918, 921, 164 USPQ 221, 223 (CCPA 1970) where the Court of Custom and Patent Appeals (CCPA), predecessor to the Federal Circuit, noted "[t]his court has often observed that minutiae of descriptions or procedures perfectly obvious to one of ordinary skill in the art yet unfamiliar to laymen need not be set forth."

Finally, with regard to determining whether the an applicant has satisfied the "written description" requirement of 35 USC §112, as with other issues before the Patent and Trademark Office the examiner has the burden of establishing a *prima facie* case. Specifically, as noted by the Federal Circuit in *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), the Court said:

The *prima facie* case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990). The term "*prima facie* case" refers only to the initial examination step. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.

After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance

of evidence with due consideration to persuasiveness of argument. See *In re Spada*, *supra*; *In re Corkill*, 771 F.2d 1496, 1500, 226 USPQ 1005, 1008 (Fed. Cir. 1985); *In re Caveny*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985); *In re Johnson*, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984).

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. See *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985); *In re Rinehart*, *supra*. (emphasis added).

*In re Oetiker*, 24 USPQ2d at 1444.

In this regard, the Federal Circuit has confirmed the view of its predecessor the Court of Customs and Patent Appeals in *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 97 (CCPA 1976) that "the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." see *In re Alton*, 76 F3d 1168, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996).

#### IV. THE OFFICIAL ACTION

As noted at the outset of Applicants' Remarks, in rejecting Applicants' claims 1-51 pursuant to the "written description" requirement of 35 USC §112, the Examiner contended, Applicants' specification did not "support" certain elements recited in those claims. Particularly, the Examiner asserted, in principal part, that Applicants' written description did not support "a location designation"; or "an advertiser host to provide advertising content"; or "an advertisement host"; or certain of their respective functionality during operation.

More specifically, with regard to claim 1, the Examiner asserted that Applicants' specification did not disclose four separate entities as claimed, specifically: a user reception system, a content host, an advertiser host, and an advertisement host. In that regard, the Examiner indicated it was unclear which specification elements corresponded to the claimed advertiser host and which to the advertisement host. The Examiner then went on to say that he failed to find in the specification support for the limitation "a location



designation.” Still further, the Examiner represented that Applicants’ specification did not have support for the function performed by the advertisement host as recited in claim 1, namely, “ responsive to a request for user reception system based on location designation to select an advertiser host.”

As to claims 2-4, the Examiner said that the specification lacks support for the limitation: “the advertisement host selects the advertiser host.” The Examiner further noted he failed to find teaching in the specification of a host selecting another host in order it to serve advertising content to the user reception system.

Continuing, with regard to claims 7-12 and 13-18, the Examiner noted that he rejected the noted claims on the same basis that he rejected claims 1- 6.

As to claims 19-22 and 23- 28, the Examiner represented that Applicants’ specification lacked support for the limitation: “the location designation” provided by the content host, and an advertisement host responsive to a request from the user reception system based on the location designation to select advertising content.

Regarding claim 20, the Examiner maintained that Applicants’ specification lacked support for the limitation: “the advertisement host selects the advertiser host....”

Concerning claims 29-31, the Examiner contended that Applicants’ specification lacked support for the limitation: “a content host ... providing a location designation to the user reception system identifying the network address of the advertisement host ... for providing advertising content.”

With respect to claims 32-37, the Examiner stated that Applicants’ specification lacked support before the claimed advertiser host and the advertisement host limitations.

Regarding claim is 38-40, the Examiner maintained that Applicants’ specification lacked support for the claimed “location designation” and certain identified steps recited in the noted claims.

As to claims 41-46, the Examiner stated the specification lacked support for the claimed “location designation” and, again, certain of the steps described in the noted claims.

Regarding claims 47-50, the Examiner maintained that Applicants' specification lacked support before limitations similar to those appearing in claims 41-46 noted previously.

Finally, for claim 51, the Examiner asserted that Applicants' specification lacked support for the "location designation" limitation appearing in a series of limitations included in claim 51.

## **V. APPLICANTS' RESPONSE TO THE EXAMINER'S GROUNDS OF REJECTION**

Applicants would respectfully submit that the Examiner's contentions regarding the inadequacy of Applicants' written description pursuant to 35 USC §112, Para. 1 are erroneous. As demonstrated above in the description of Applicants' disclosed system and its modes of operation, one skilled in the art upon reasonably reviewing Applicants' specification would recognize Applicants were in possession of the invention as claimed when filed on. Further, Applicants would respectfully submit the Examiner failed to apply the criterion and considerations the Court of Appeals for the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals, have long maintained for assessing adequacy of the "written description" requirement of 35 USC §112. Particularly, the Examiner has failed to correctly assess what Applicants' specification, in fact, expressly teaches. Additionally, the Examiner has failed to consider whether matter the Examiner contends is missing from Applicants' written description would have been reasonably understood by one of ordinary skill in the art based on what Applicants' written description does disclose. Still further, the Examiner failed to consider that Applicants are not required to expressly include in their written description all matter known by persons skilled in the art to which Applicants' invention relates. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111, 116 (Fed. Cir. 1991); *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F3d 989, 54 USPQ2d 1227 (Fed. Cir. 2000); *In re Lukach*, 442 F.2d 967, 969,

169 USPQ 795, 796 (CCPA 1971); *In re Eltgroth*, 419 F.2d 918, 921, 164 USPQ 221, 223 (CCPA 1970).

Yet additionally, Applicants would respectfully submit that by the noted failures and the further failure of not presenting evidence of why persons skilled in the art would not recognize that Applicants' written description discloses the invention defined by the claims, the Examiner has failed to establish a *prima facie* case of unpatentability for claims 1-51 pursuant to the "written description" requirement of 35 USC §112. *See, In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 97 (CCPA 1976); *In re Alton*, 76 F3d 1168, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996).

Still further, Applicants would respectfully submit that full review of their disclosure demonstrates that Applicants expressly teach placement of the identification code "ADSLOT" in ad partitions of an application page layouts supplied by the file server, which code "locates," in simplified operation of Applicants' system, the high function host of Applicants' information layer, that, in turn, identifies user-targeted advertisement content which can be retrieved, for example, from a gatewayed advertiser host, and placed in respective ad partitions presented to the user. As such, the ADSLOT identification code constitutes "a location designation" for Applicants' high function host and its subsequent identification of targeted advertising to be displayed.

Additionally, Applicants would respectfully submit that full review of their disclosure demonstrates that Applicants expressly teaches use of information layer computing resources, particularly, the high function host, that supplies and receives network information to serve as a source for lists; i.e., queues, of identifiers for advertising objects targeted to respective users; and, further, receive user-activity information originated at respective user reception systems to enable user advertising targeting, which, thereby, constitute "an advertisement host." Yet, additionally, Applicants would respectfully submit that full review of their disclosure demonstrates that Applicants expressly teach

employment of respective "advertiser hosts" that users access over network gateways to provide advertising content information to users who have requested advertising.

Accordingly, Applicants would respectfully submit that contemplation of Applicants' express teaching regarding the ADSLOT location designation of the high function host; high function host operation; and access to gatewayed advertisers by those skilled in the art would make it obvious to those skilled in the art that as of Applicants' effective filing date, Applicants possessed a networked system for presenting targeted advertising to users as described in pending claims 1-51.

Therefore, Applicants' would further respectfully submit that their disclosure does, in fact, include a written description that complies with 35 USC §112, Para. 1, and that the Examiner's rejection of pending claims 1-51 must be withdrawn.

#### **A. Claim 1**

Concerning the Examiner's rejection of claim 1, as noted the Examiner asserted Applicants' specification did not disclose four separate entities as claimed, specifically: a user reception system, a content host, an advertiser host, and an advertisement host.

Applicants would respectfully submit, however, that the Examiner has not fairly interpreted Application specification or considered how those skilled in the art would understand it relative to the disclosure of a four-element system configuration. As shown in Applicants' figure and described in the companion specification text, and as pointed out above, in the explanation of Applicants' disclosed system, Applicants' system includes a file server and associated application object and advertising object database. Further, Applicants' system includes a multiplicity of user reception units which communication with the file server and other network components. Still further, Applicants' system includes an information layer including: "high function system" computing resources; "producer system" computing resources; and "business support system" computing resources. In accordance with Applicants' teaching, the high function system operates online and collects user experience and demographic data for profiling users, and

additionally manages the production of advertising lists; i.e., queues, targeted; i.e., custom tailored, to users by the offline business support system.

Further, the high function system supervises user logon to the system and provides respective user reception units that logon to the system with: data for activating the user-activity data collection manager; ad queues of targeted advertising; as well as parameters for configuring the user reception system ad queue manager. Still further, during online operation, the high function host receives requests from respective user reception units for additional targeted ad queues as ads are displayed and the initial ad queues depleted. And, yet further, during online operation, the high function host receives data from user reception unit data collection managers concerning user activity experience, which the high function host subsequently makes available for offline modification of user profiling and preparation of user targeted ad queues.

In view on the described operation of the high function system, and its supply and receipt of operating information, it is apparent that in accordance with Applicants' teaching the high function system operates as a hosting facility. And, in view of the high function host's operation in connection with data collection for advertising targeting, and supply and support of targeted ad queues including ad object ids; i.e., object addresses, the high function host clearly operates as an advertisement host.

Continuing with reference to Applicants' network architecture, Applicants' system is additionally seen to include a "gateway system" that permits user reception systems to be operationally connected to third-party hosts; e.g., advertiser hosts, that are able to supply application and advertising content to requesting user reception systems. Particularly, just as objects are able to include display data and/or program code which calls for advertising objects from the file server and information layer host, object may also include calls for access to third-party hosts of advertisers over the gateway system, thereby, enabling the gatewayed advertiser hosts to supply interactive advertising content that may be displayed at respective user reception systems.

In view of the above description, Applicants would respectfully submit that Applicants' system expressly contemplates network configurations that include four separate entities: e.g., a user reception system; i.e., the reception systems; a content host; i.e., the file server; an advertiser host; i.e., gatewayed hosts of advertisers; and an advertisement host; i.e., the high function host. Still further, Applicants would respectfully submit that those skilled in the art would readily recognize such a four-element configuration, and the Examiner has offered no evidence to show otherwise.

Also in connection with the rejection of Applicants' claim 1, the Examiner represented he failed to find support for a "location designation" in Applicants' specification.

In that regard, Applicants would again respectfully submit that the Examiner has not fairly interpreted Application specification or considered how those skilled in the art would understand it relative, in this case to Applicants' disclosure a "location designation." Here also, as described in the specification text, and as explained above, in the description of Applicants' disclosed system, Applicants' system includes a location designation.

As explained above in connection with the description of Applicants' system operation, when in the course of building an application page requested by the user from Applicants' file server; i.e., content host, as the reception system object processor encounters a call to an "ADSLOT" identification code associated with an ad page partition, in accordance with Applicants' disclosed preferred operation, the object processor requests the next advertising object id at the reception system ad manager ad queue, which, as explained arises from the high function host; i.e., advertisement host, and the identified advertising object is retrieved based on the object id either locally, or from the network depending on availability, so that the presentation data for the advertising can be displayed.

Additionally, as further pointed out above, in the case of simplified system operation; i.e., where because of limited concern for the problems of host complexity and communication, Applicants' use of an ad queue at the user reception and pre-fetching of ad object ids are suspended, the ADSLOT identification code is a location designator that points to the high function host; i.e., the advertisement host, to obtain designation of a

targeted ad id, the object for which, by virtue of the Applicants' disclosed object architecture and operation, is capable of recovering advertising content at the user reception system from a gatewayed advertiser host; i.e., the advertiser host.

More specifically, and as described above in connection with the description of simplified operation of Applicants' system, as the user reception system builds the initial application page of an application requested by the user from the file server, and the reception system object processor encounters an ad page partition that includes an ADSLOT identification code, the ADSLOT code immediately "locates" Applicants' high function host by calling the reception system ad manager for an ad object id, which, because of the absence of any ad queue, requires the ad manager to immediately call to the high function host for the id of a targeted ad, as the ad manager would otherwise do to replenish the ad queue if it were present. In response, the high function host then does what it would otherwise do if an ad queue were present at the user reception system, namely, designate a target ad id for the user based on known characteristics of the user, and return the id to the reception ad manager, which, then, provides the id to the object processor. Subsequently, the object processor calls the object for the ad initial page the high function host has designated based on the virtual address contained in the object id, and when received, includes the object at the ad page partition that carried the ADSLOT code. Thereafter, the application page with the associated initial page of the targeted ad is presented at the user reception system.

Following the noted procedure, there would be available at the user reception system the application page the user originally requested, together with the initial page of a concurrently presented ad, the ad initial page including the identification for the subsequent page of the ad in the form of a call and associated program instructions to retrieve the ad subsequent page.

Thereafter, if the user selects; i.e., activates, the initial page of the concurrently presented ad, the program code of the object associated with the initial ad page will cause the subsequent ad page to be retrieved based on the address contained in the header of the

subsequent ad page object called in that process and/or instructions to contact a gatewayed host; e.g., an advertiser host, for additional advertising content.

Accordingly, and as would be appreciated by those skilled in the art, in simplified operation, where the Applicants' system is configured in a four element configuration, namely: a content host; i.e., file server; reception system; advertiser host; i.e., gatewayed host; and an advertisement host; i.e., high function host, the ADSLOT identification code, when received from the file server with application content, acts as a "location designation" that locates the high function host, which, in turn, designates the id of an advertising object targeted to the user, that when included in the application page enables the user, based on the content of the designated ad object, to obtain subsequent ad content from a gatewayed advertiser host; i.e., the advertiser host.

In view of the above description, Applicants would respectfully submit that Applicants' system contemplates a "location designation" for operation cooperation with a four-entity network configuration. Still further, Applicants would respectfully submit that those skilled in the art would readily recognize such a "location designation" and the Examiner has offered no evidence to show they would not or could not.

Finally with respect to the Examiner's rejection of claim 1, he asserts that Applicants' specification does not support the advertisement host function of: "responsive to a request from a user reception system based on location designation to select an advertiser host."

Here also Applicants would respectfully submit that the Examiner has not fairly interpreted Application specification or considered how those skilled in the art would understand it relative, the operation of the high function host and its performance as an advertisement host. As explained just above in connection with the "location designation" and as earlier described in connection with the explanation of the high function host as an advertisement host, the role of the high function host is to identify ad objects targeted to user and to associate the ids of such ad object with respective users. Further, as also preciously explained, ad objects are created with display data and program code that with provide users with advertising content that can be secured from gatewayed advertiser



hosts. Accordingly, when the high function host associates a user with specific advertising, the high function is selecting the advertiser the user will "see" when the ADSLOT location designation calls for the high function host to identify a suitable ad object id.

Here again, based at least on the above description, Applicants would respectfully submit that Applicants' system contemplates the high function host; i.e., the advertisement host, selecting a gatewayed advertiser host; i.e., the advertiser host, for the reception system based on an ADSLOT location designation in simplified operation. And, Applicants respectfully submit that those skilled in the art would readily recognize such operation, and the Examiner has offered no evidence to show otherwise.

#### **B. Claim 2-4**

With regard to the rejection of claims 2-4, as explained, the Examiner contends Applicants' specification lacks support for the limitation: "the advertisement host selects the advertiser host."

Once more, Applicants would respectfully submit that the Examiner has not fairly interpreted Application specification or considered how those skilled in the art would understand it relative, the operation of the high function host and its performance as an advertisement host. As explained in connection the similar support objection raised in claim 1, the high function host; i.e., advertisement host, selects the advertiser host by virtue of the ad object the high function host designates for targeting to the user, the ad object fully identifying what is to be presented and how. See in this regard, the discussion given in connection with claim 1, which for the sake of brevity is incorporated here by reference.

Again, for the noted reasons, Applicants would respectfully submit that Applicants' system contemplates the high function system; i.e., the advertisement host, selecting a gatewayed advertiser host; i.e., the advertiser host. Applicants respectfully submit that those skilled in the art would readily recognize such operation, and the Examiner has offered no evidence to show otherwise.

### **C. Claims 7-12 and 13-18**

With regard to claims 7-12 and 13-18, the Examiner notes that he rejected the noted claims on the same basis that he rejected claims 1-6. In reply, Applicants would respectfully submit that for the reasons given in response to the Examiner's rejection of claim 1-6, which for brevity are incorporated here by reference, Applicants respectfully submit the Examiner's rejection of Claims 7-12 and 13-18, is improper, and must be withdrawn.

### **D. Claims 19-22 and 23- 28**

As to claims 19-22 and 23- 28, the Examiner represented that Applicants' specification lacked support for the limitation: "the location designation provided by the content host", and "an advertisement host responsive to a request from the user reception system based on the location designation to select advertising content."

Once again, Applicants would respectfully submit that the Examiner has not fairly interpreted Application specification or considered how those skilled in the art would understand it as it concerns the ADSLOT location designation and its operation, and the high function host; i.e., advertisement host, and its operation.

For the reasons given in response to the Examiner's rejection of claim 1-6, which for brevity are incorporated here by reference. Applicants respectfully submit the Examiner's rejection of Claims 19-22 and 23- 28, are improper and must be withdrawn. As noted in connection with Applicants' rely to the rejection of claim 1, the ADSLOT location designation is included in the object structure for the application content requested by the user from the file server; i.e., content server. Further, as also noted in reply to the rejection of claim 1, the high function host selects advertising content based on the ad object targeted to respective users. Further, the ad targeting designations of the high function host is obtained based on the user request for application and their respective object content which provide the described ADSLOT location designation.

### **E. Claim 20**

In regarding claim 20, the Examiner asserted that Applicants' specification lacks support for limitation: "the advertisement host selects the advertiser host...."

Applicants would respectfully submit that the Examiner rejection of claim 20 is, in effect, the same grounds of rejection asserted against claim 2-4. Accordingly, for the reasons given in response to the Examiner's rejection of claim 2-4, which for brevity are incorporated here by reference, Applicants respectfully submit the Examiner's rejection of Claim 20 is improper and must be withdrawn.

### **F. Claims 29-31**

In the case of claims 29-31, the Examiner contended that Applicants' specification lacked support for the limitation: "a content host ... providing a location designation to the user reception system identifying the network address of the advertisement host ... for providing advertising content.

Once more, Applicants would respectfully submit that the Examiner rejection of claims 29-31 are substantially the same as prior rejections, here, the rejections of claims 1-6; 19-22 and 23-28. Accordingly, for the reasons given in response to the Examiner's rejection of claims 1-6; 19-22; and 23-28, which for brevity are incorporated here by reference, Applicants respectfully submit the Examiner's rejection of claim 29-31 is improper and must be withdrawn. With regard to the Examiner's reference to the term "network address" in the noted limitation, Applicants would point out that it is well known in the art that no messaging and or data communication can be undertaken in a network without suitable "network address(es)" accordingly, in view of Applicants' extensive disclosure concerning messaging in their system for both communication of literal strings and object supply and support, it would be appreciated by those skilled in the art that Applicants likewise incorporate network addresses in their system.

### **G. Claims 32-37**

As to the rejection of claims 32-37, the Examiner states that Applicants' specification lacked support before the claimed advertiser host and the advertisement host limitations.

Applicants would respectfully submit that again the Examiner rejection of claims 32-37 is substantially the same as a prior rejection, particularly, the rejection of claim 1. Therefore, for the reasons given in response to the Examiner's rejection of claim 1, which for brevity is incorporated here by reference, Applicants respectfully submit the Examiner's rejection of claims 32-37 is improper and must be withdrawn.

### **H. Claims 38-40**

Regarding the rejection of claim is 38-40, the Examiner maintains that Applicants specification lacked support for the claimed "location designation" and certain identified steps recited in the noted claims.

Applicants would respectfully submit that once again the Examiner rejection of claims 38-40 is substantially the same as prior rejections, particularly, the rejections of claims 1-6. Therefore, for the reasons given in response to the Examiner's rejection of claims 1-6, which for brevity is incorporated here by reference, Applicants respectfully submit the Examiner's rejection of claims 38-40 is improper and must be withdrawn.

### **I. Claims 41-46**

Concerning the rejection of claims 41-46, the Examiner states the Applicants' specification lacks support for the claimed "location designation" and, again, certain of the steps described in the noted claims.

Applicants would respectfully submit that once again the Examiner rejection of claims 41-46 is substantially the same as prior rejections, particularly, the rejections of claims 1-6. Therefore, for the reasons given in response to the Examiner's rejection of claims 1-6, which for brevity is incorporated here by reference, Applicants respectfully submit the Examiner's rejection of claims 41-46 is improper and must be withdrawn. With regard to

the dialogue between the user reception system and the gatewayed advertiser, as explained above and in Applicants' specification regarding gateway messaging, it is apparent that Applicants' expressly disclose and teach the manner and character of such communications, and particularly note the example dialogue conducted by such third-party gatewayed hosts as Dow Jones.

#### **J. Claims 47-50**

Regarding the rejection of claims 47-50, the Examiner asserts that Applicants' specification lacked support before limitations similar to those appearing in claims 41-46 noted previously.

With regard to claims 47-50, since the Examiner notes that he rejected the noted claims on the same basis that he rejected claims 41-46, which as Applicants noted in connection with claims 41-46 were substantially the same as the rejection of claims 1-6. In reply, Applicants would respectfully submit that for the reasons given in response to the Examiner's rejection of claims 41-46, and 1-6, which for brevity are incorporated here by reference, Applicants respectfully submit the Examiner's rejection of Claims 47-50, are improper, and must be withdrawn.

#### **K. Claim 51**

Finally, in rejecting claim 51, the Examiner asserted that Applicants' specification lacked support for the "location designation" limitation appearing in a series of limitations included in claim 51.

Applicants would respectfully submit that once again the Examiner rejection of claim 51 is substantially the same as prior rejections, particularly, the rejections of claims 1-6. Therefore, for the reasons given in response to the Examiner's rejection of claims 1-6, which for brevity is incorporated here by reference, Applicants respectfully submit the Examiner's rejection of claim 51 is improper and must be withdrawn.

## VI. CONCLUSION

As noted above, Applicants would respectfully submit that the Examiner's contentions regarding the inadequacy of Applicants' written description pursuant to 35 USC §112, Para. 1 are erroneous. As demonstrated above in the description of Applicants' disclosed system and its modes of operation, one skilled in the art upon reasonably reviewing Applicants' specification would recognize Applicants were in possession of the invention as claimed when filed on. Further, Applicants would respectfully submit the Examiner failed to apply the criterion and considerations the Court of Appeals for the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals, have long maintained for assessing adequacy of the "written description" requirement of 35 USC §112. Particularly, the Examiner has failed to correctly assess what Applicants' specification, in fact, expressly teaches. Additionally, the Examiner has failed to consider whether matter the Examiner contends is missing from Applicants' written description would have been reasonably understood by one of ordinary skill in the art based on what Applicants' written description does disclose. Still further, the Examiner failed to consider that Applicants are not required to expressly include in their written description all matter known by persons skilled in the art to which Applicants' invention relates. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111, 116 (Fed. Cir. 1991); *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 54 USPQ2d 1227 (Fed. Cir. 2000); *In re Lukach*, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971); *In re Eltgroth*, 419 F.2d 918, 921, 164 USPQ 221, 223 (CCPA 1970).

Yet additionally, Applicants would respectfully submit that by the noted failures and the further failure of not presenting evidence of why persons skilled in the art would not recognize that Applicants' written description discloses the invention defined by the claims, the Examiner has failed to establish a *prima facie* case of unpatentability for claims 1-51 pursuant to the "written description" requirement of 35 USC §112. *See, In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Wertheim*, 541 F.2d 257, 262,

191 USPQ 90, 97 (CCPA 1976); *In re Alton*, 76 F3d 1168, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996).

Still further, Applicants would respectfully submit that full review of their disclosure demonstrates that Applicants expressly teach placement of the identification code "ADSLOT" in ad partitions of an application page layouts supplied by the file server, which code "locates," in simplified operation of Applicants' system, the high function host of Applicants' information layer, that, in turn, identifies user-targeted advertisement content which can be retrieved, for example, from a gatewayed advertiser host, and placed in respective ad partitions. As such, the ADSLOT identification code constitutes "a location designation" for Applicants' high function host and its subsequent identification of targeted advertising to be displayed.

Additionally, Applicants would respectfully submit that full review of their disclosure demonstrates that Applicants expressly teaches use of information layer computing resources, particularly, the high function host, that supplies and receives network information to serve as a source for lists; i.e., queues, of identifiers for advertising objects targeted to respective users; and, further, receive user-activity information originated at respective user reception systems to enable user advertising targeting, which, thereby, constitute "an advertisement host." Yet, additionally, Applicants would respectfully submit that full review of their disclosure demonstrates that Applicants expressly teach employment of respective "advertiser hosts" that users access over network gateways to provide advertising content information to users who have requested advertising.

Accordingly, Applicants would respectfully submit that contemplation of Applicants' express teaching regarding the ADSLOT location designation of the high function host; high function host operation; and access to gatewayed advertisers by those skilled in the art would make it obvious to those skilled in the art that as of Applicants' effective filing date, Applicants possessed a networked system for presenting targeted advertising to users as described in pending claims 1-51.

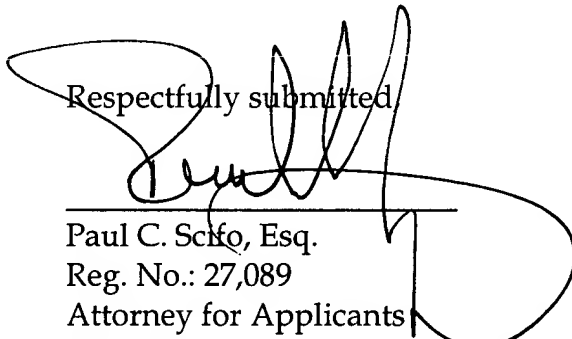
Therefore, Applicants' would further respectfully submit that their disclosure does, in fact, include a written description that complies with 35 USC §112, Para. 1, and that the Examiner's rejection of pending claims 1-51 must be withdrawn.

Therefore, in view of the foregoing remarks, Applicants would respectfully submit that their invention as claimed is patentably distinguished from the art, and that the Examiner's rejection of Applicants' claims 1-51 pursuant to 35 U.S.C. §112, Para. 1 on contended grounds that Applicants' written description is inadequate is without basis in law or fact. Accordingly, Applicants requests reconsideration of their application and allowance of the pending claims 1-51.

In closing, Applicants would respectfully note, that in the event the Examiner has any questions regarding Applicants' remarks here or otherwise concerning the adequacy of Applicants' written description, Applicants' attorney would be pleased to meet with the Examiner convenience to full discuss them.

Dated: May 23, 2002

Respectfully submitted,

  
Paul C. Scifo, Esq.  
Reg. No.: 27,089  
Attorney for Applicants  
10 Lee Court  
Franklin Square, New York 11010  
(516) 488-2315

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, post office to addressee service, EU050434035US in an envelope addressed to the Assistant Commissioner of Patents Washington, D.C. 20231, on May 23, 2002

Name of Registered Representative: Paul C. Scifo, Esq.

Signature:

Date: May 23, 2002